

REMARKS

In the Office Action, the Examiner rejected claims 1, 2, 4-8, 10-36 and 61-77 under 35 USC §103(a). In addition, the Examiner withdrew claims 78-90 from consideration.

Claim 1 has been amended to further clarify the subject matter regarded as the invention. Claims 1, 2, 4-8, 10-36 and 61-90 remain pending in the application.

Reconsideration of the application is respectfully requested based on the following remarks.

RESTRICTION REQUIREMENT

In the Office Action, the Examiner withdrew claims 78-90 from consideration as being drawn towards a non-elected invention. Applicants respectfully request consideration on the grounds that it would be more expedient for Applicants and not an undue burden on the Examiner to also consider claims 78-90 in this application.

PATENTABILITY OF CLAIMS 1, 2, 4-8, 10-36 AND 61-77

In the Office Action, the Examiner rejected claims 1, 2, 4, 5, 7 and 10 under 35 U.S.C. § 103(a) as unpatentable over Breen, Jr. et al., U.S. Patent No. 6,598,027, in view of Tracy et al., U.S. Patent No. 5,979,757; rejected claims 16, 17, 20, 22-24, 27, 29-31, 35, 61-63, 67, 69-72 and 73-77 under 35 U.S.C. § 103(a) as unpatentable over Breen, Jr. et al. in view of Tomsen, U.S. Patent Publication 2002/0013950 A1; rejected claims 1-6, 8, 10-20, 22-27, 29-34, 36, 61-66 and 68-74 under 35 U.S.C. § 103(a) as unpatentable over Matsuo et al., U.S. Patent Publication No. 2001/0042021 A1, in view of Tomsen and further in view of and further in view of Tracy et al. These rejections are fully traversed below.

Claim 1 pertains to a computer-implemented method for implementing electronic commerce transactions. The method includes the operations of "identifying a regulated item selected by a customer, the regulated item corresponding to an item which satisfies one or more predetermined criteria, the one or more predetermined criteria indicating that the item is prohibited from being

purchased by the customer, the one or more predetermined criteria corresponding to at least one regulation which restrict sales of the regulated item to persons in a particular jurisdiction; and taking action, other than or in addition to presenting a notification message, to prevent the purchase of the regulated item via the data network by the customer in accordance with the at least one regulation” (claim 1, lines 3-10).

Additionally, claim 1 recites “the at least one regulation restricts sales of the regulated item during at least one specific day.” As to this limitation, the Examiner admits on page 3 of the Office Action and subsequently on page 6 of the Office Action that neither Breen et al., Matsuo et al. nor Tomsen disclose such a limitation. To overcome these deficiencies, the Examiner relies on Tracy et al., namely, column 13, line 57 to column 14, line 2 of Tracy et al.

Tracy et al. pertains to a portable shopping system. The portable shopping system uses a portable terminal that includes a machine code reader (e.g., bar code reader) and a central computer. At col. 13, line 57 to col. 14, line 2 of Tracy et al., it is discussed that the central computer can inform a customer [of a self-scan system] that a selected item is a restricted item and cannot be purchased by the customer at that time. “For instance, in some states alcoholic beverages may not be sold on Sundays. Thus, if a consumer scans the product for purchase, the portable terminal will display a message or play an audible message conveying the prohibition.” Tracy et al., col. 13, lines 60-64.

As best, Tracy et al. serves to inform a potential customer that purchase of an item is restricted. Nothing, however, teaches or suggests that the purchase or delivery of the restricted item is in any way prevented in a computer-implemented manner during specific days by the portable shopping system of Tracy et al. The specifics of presenting a message about the restriction, as noted in Tracy et al., may even teach against preventing delivery or purchase of restricted items. Moreover, the action taken by the method of claim 1 is in addition to or other than presenting a notification message. The presentation of a message in Tracy et al. cannot be such an action. Thus, Tracy et al. is unable to overcome the deficiencies of Breen et al., Matsuo et al. and Tomsen noted above. Accordingly, it is submitted that claim 1 is patentably distinct from Matsuo et al., Breen et al., Tomsen and/or Tracy et al., alone or in combination.

Claim 16 pertains to a computer-implemented method for implementing electronic commerce transactions via a data network. The method generally operates to identify a regulated

item selected by a customer and then take action to prevent the purchase of the regulated item. In addition, claim 16 recites "wherein said taking action comprises modifying a display of items available for purchase by the customer, wherein the display modification includes restricting display of items which are prohibited from being purchased by the customer based upon the one or more predetermined criteria."

Breen, Jr. et al. describes a system and method for conducting commercial transactions, namely, online bidding, for regulated goods via a computer network. Matsuo et al. describes an electronic settling system and method capable of executing settlements on the Internet.

In the Office Action, the Examiner admits that neither Breen, Jr. et al. nor Matsuo et al., discloses the modification of a display of items available for purchase by a customer by restricting display of items which are prohibited from being purchased by the customer. To overcome the admitted deficiency of Breen, Jr. et al. and Matsuo et al., the Examiner relies on Tomsen. First, we note that Tomsen pertains to an interactive television system that allows a user to save content and context related to a transaction. "As an example, while the viewer is watching a television commercial, the viewer can defer a transaction related to a product advertised in the television commercial or defer the viewing of the television commercial itself." See Abstract. An interactive television system is in a substantially different field of endeavor than the online bidding systems of Breen, Jr. et al. or the electronic settling systems of Matsuo et al. Second, the problems being solved in each of Breen, Jr. et al., Matsuo et al. and Tomsen are completely different. Accordingly, it is submitted that one skilled in the art would not be motivated to combine these references as proposed by the Examiner.

As explained below, even if Tomsen were proper to be combined with either Breen, Jr. et al. or Matsuo et al., the combination would still be deficient.

In the Office Action, the Examiner admits that Breen, Jr. et al. and Matsuo et al. both "fails to explicitly disclose modifying a display of items available for purchase by the customer by restricting display of items, which are prohibited from being purchased by the customer." Office Action, pages 4 and 6. In an effort to remedy this serious deficiency, the Examiner points to the "family safe" feature described in Tomsen. See, e.g., Tomsen, page 4. Figures 7-9 illustrate features of the family safe.

In general, in Tomsen, a user of an interactive television can initiate a transaction associated with a television commercial. Once initiated, the transaction can be deferred. "In one embodiment, deferral of the transaction includes saving information (such as information previously entered by the viewer, product supplemental information, URLs and/or content of web sites accessed, transaction status information, hypertext markup language (HTML) code or other code, metatags and related descriptions of the advertised product, "snapshots" of the television commercial, or other information useable for future completion of the transaction)." Tomsen, page 4, para. 40. "Such saved information is also useable to provide the viewer with a context in which the original transaction was made, whenever the viewer resumes the transaction." Tomsen, page 4, para. 40. Moreover, Tomsen explains use of the family safe 702 as follows:

[0043] The family safe 702 can display a listing 706 of items, such as a listing of pending transactions, previously completed transactions, canceled transactions, etc. The family safe 702 may provide more than simple shopping cart functionality. It may also store information such as the shipping address of the family, restrictions on purchases by individual family members (for example, children), credit card information if applicable, bonus point ("mileage") plan information if applicable, and so on. Account information, advertising, instructions, product information, or other information may also be displayed in the family safe 702. In the example shown in FIG. 7, the previously initiated and deferred transaction for the shoes is identified at 704. If the viewer is interested in resuming the transaction for the shoes, then the viewer can use the remote control unit 158 to send a command to the set top box 152 to resume the transaction (e.g., the viewer can click on the particular item listed in the family safe 702). Such an action/command can result in submission/authorization for the order, the display of additional information, or other transaction-related activities.

[0044] As an example, FIG. 8 shows graphics, text, and other information 802 related to the shoes that can be displayed in response to the viewer's "clicking" of the item 704 in the family safe 702. The displayed information 802 can include a picture of the shoes, as well as product supplemental information describing the shoes and other displayed information useable for the transaction. The displayed information 802 can further include a "commercial" button 804 and a "buy" button 806. If the viewer clicks the buy button 806, then subsequent completion of the transaction can occur.

Tomsen, among other things, describes an electronic shopping cart, referred to as a "family safe." FIG. 7 shows a family safe 702 displaying a listing 706 of items, such as a listing of pending transactions, canceled transactions, etc. Specifically, in FIG. 7, the previously initiated and deferred

transaction pertaining to a pair of shoes is identified at 704. See, Tomsen, page 4, paragraph 0043. Hence, Tomsen merely teaches that a list of transactions can be deferred and then subsequently displayed in the family safe 702 (i.e., electronic shopping cart). There is no notion of regulated items or prohibitions on purchasing of regulated items. Nothing in Tomsen teaches or suggests that a display of items available for purchase by a customer can in any way be restricted so that prohibited items are not displayed. Thus, Tomsen is not able to overcome the deficiencies of either Breen, Jr. et al. or Matsuo et al. noted above.

Therefore, it is submitted that claim 16 is patentably distinct from Breen, Jr. et al. in combination with Tomsen as well as patentably distinct from Matsuo et al. in combination with Tomsen and Tracy et al. Other independent claims 23, 30 and 61 also require restrictive display of prohibited items in electronic commerce transactions. Hence, for similar reasons, it is submitted that claims 23, 30 and 61 are also patentably distinct from Breen, Jr. et al. in combination with Tomsen as well as patentably distinct from Matsuo et al. in combination with Tomsen and Tracy et al.

Accordingly, it is submitted that the independent claims 1, 16, 23, 30 and 61 are patentably distinct from any combination of Breen, Jr. et al., Tomsen, Matsuo et al. and/or Tracy et al. In addition, it is submitted that dependent claims 2, 4-8, 10-15, 17-22, 24-29, 31-36 and 62-77 are also patentably distinct for at least the same reasons. Additional limitations recited in the independent claims or the dependent claims are not further discussed as the above-discussed limitations are clearly sufficient to distinguish the claimed invention from Breen, Jr. et al., Tomsen, Matsuo et al. and/or Tracy et al. Thus, it is respectfully requested that the Examiner withdraw the rejections under 35 USC § 103(a).

SUMMARY

It is submitted that the rejections of the claims have been traversed. Therefore, it is submitted that claims 1, 2, 4-8, 10-36 and 61-90 are in condition for allowance. Reconsideration of the application and an early Notice of Allowance are earnestly solicited.


If there are any issues remaining which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below.

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Applicants hereby petition for an extension of time which may be required to maintain the pendency of this case, and any required fee for such extension or any further fee required in connection with the filing of this Amendment is to be charged to Deposit Account No. 50-0388.

Respectfully submitted,



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